

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office Action dated December 9, 2004 are respectfully requested. By this response, claims 43, 45 and 46 are being amended. Support for newly added limitations may be found at, for example, page 6, lines 19-30.

The applicant's representative wishes to thank the Examiner for the thorough office action, including the specific recitation of portions within the applied references with respect to certain claims.

The rejections under double patenting will first be discussed, followed by the rejection under 35 U.S.C. 112, second paragraph. Embodiments of the invention are discussed next, followed by brief discussions of the applied references Pan and Kinzalow. Finally, the distinctions between claim 45 and the applied references are discussed, followed by distinctions between the applied references and the remaining independent claims.¹

1. Claim Rejections – Double Patenting

Claims 37-42, 45-48 and 51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,636,749 to Holmes et al. alone or in view of U.S. Patent No. 6,304,674 to Pan.

A terminal disclaimer in compliance with 37 C.F.R. 321(c) is provided along with this response limiting the term of the pending application and indicating common inventorship and ownership of the pending application and the cited patent.

¹ Silence regarding a position taken by or argument made by the Examiner does not indicate any acquiescence to that position or argument. Furthermore, arguments made with respect to a particular claim or claims apply only to that claim or claims, and not to other claims, unless specifically noted herein.

Although applicants are filing herewith a terminal disclaimer to overcome the double patenting rejections, applicants submit that claims 37-51 are also patentable for the reasons stated below (e.g. claims require two-way communications, "wireless protocol" excludes traditional analog FM transmission and encompasses transmitting and receiving packetized data, etc.).

2. Claim Rejections Under 35 U.S.C. 112

Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, the Examiner states that "IEEE 802.11" is indefinite because there "are multiple versions of the standard which have different means for different applications." Claim 46 has been amended to recite "the IEEE 802.11 family" in order to clearly define the element to comprise all versions of the 802.11 protocol.

3. Embodiments of the Claimed Invention

The claimed invention is directed to an apparatus and method of adding wireless protocol capability to a charge cord. This provides a wireless device connected to the charge cord with wireless protocol capability and electrical power, both from the same attachment. For example, the wireless device may be a wireless phone, and is connected to a vehicle via the charge cord. Upon connection, the wireless phone in this example receives electrical power from the vehicle and at the same time utilizes the wireless protocol capability of the charge cord (e.g. Bluetooth capabilities) in order to communicate with a hands-free car kit in the vehicle, with a wireless headset, etc.

4. The Pan Reference

Pan discloses a hands-free cellular phone kit that contains an electrical circuit and connector for exchanging audio information with a connected cellular phone. In one of the embodiments, the hands-free kit transmits the audio information through an FM transmitter to the car stereo system, which can then be reproduced through the

speakers of the system. The connected cellular phone can also be recharged through the hands-free cellular phone kit. See Figure 4d.

5. The Kinzalow Reference

Kinzalow discloses a system for interfacing a cellular phone with a radio for hands-free operation. The system comprises an interface that converts incoming cellular phone signals from audio to radio frequency and transmits the newly converted radio frequency signals to a vehicle radio receiver, where the signals are reproduced over radio speakers. The system also provides power to a connected cellular phone. See column 3, lines 40-65 and column 5, lines 5-15.

6. Claim Rejections Under 35 U.S.C 102(e)

A. Claims 43, 45, 47, 48, 50 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,304,764 to Pan.

Pan fails to disclose all the limitations of the pending claims, and therefore does not establish a *prima facie* case of anticipation². As mentioned earlier, Pan describes a hands-free cellular phone kit which contains an electrical circuit and connector for exchanging audio information with a connected cellular phone. The hands-free kit, or "jack," may comprise "a FM transmission feature" including an "integrated FM transmitter circuit configured to transmit audio data to the car audio FM receiver." See column 6, lines 5-14.

Amended Claim 45 is directed to an apparatus for coupling a mobile device to a power supply and a wireless protocol enabled device comprising, among other elements, "a charge cord...for providing power from the power supply to the mobile device" and "a wireless protocol module coupled to the charge cord, the wireless protocol module for wirelessly coupling the mobile device to the wireless protocol

² MPEP section 2131, p. 70 (Feb. 2003, Rev. 1). *See also, Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. App. & Interf. 1990) (to establish a *prima facie* case of anticipation, the Examiner must identify where "each and every facet of the claimed invention is disclosed in the applied reference."); *Glaverbel Société Anonyme v. Northlake Mktg. & Supply, Inc.*, 45 F.3d 1550, 1554 (Fed. Cir. 1995) (anticipation requires that each claim element must be identical to a corresponding element in the applied reference); *Atlas Powder Co. v. E.I. duPont De Nemours*, 750 F.2d 1569, 1574 (1984) (the failure to mention "a claimed element (in) a prior art reference is enough to negate anticipation by that reference").

enabled device, wherein the wireless protocol module is configured to transmit and receive packetized data under the wireless protocol."

In contrast to the apparatus recited in claim 45, Pan does not describe, inter alia, a wireless protocol module "wherein the wireless protocol module is configured to transmit and receive packetized data under the wireless protocol." The apparatus of Pan relies on the use of FM transmission to communicate audio information to a car audio receiver, using a simple integrated FM transmission circuit. As is known to one of ordinary skill in the art, such simple FM transmitters do not have the capability of transmitting packetized data, nor the functionality of two-way transmission, both of which are standard elements of the wireless protocol. Therefore, Pan does not disclose both transmitting and receiving data. Moreover, the simple FM transmitter of Pan does not packetized data.

Because Pan does not describe at least a wireless protocol module "wherein the wireless protocol module is configured to transmit and receive packetized data under wireless protocol," it does not anticipate the claimed invention. Applicants submit that claim 45 is allowable at least for the above reasons and request that the rejection to claim 45 (and dependent claims 47, 48, 50 and 51) be withdrawn.

Claim 43 recites limitations similar to claim 45, including "integrating a wireless protocol module into a charge cord, wherein the charge cord is adapted to deliver electrical power to a wireless device from a vehicle power supply, and wherein the wireless protocol module is configured to transmit and receive packetized data under the wireless protocol." For at least the above reasons, claim 43 is also allowable and applicants request that the rejection likewise be withdrawn.

B. Claims 43, 45, 47, 48 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,052,603 to Kinzalow et al.

Kinzalow fails to disclose all the limitations of the pending claims, and therefore does not establish a *prima facie* case of anticipation. As explained above, Kinzalow discloses a system for interfacing a cellular phone with a radio for hands-free operation.

The system of Kinzalow converts incoming signals from a cellular phone from audio to radio frequency and transmits the newly converted radio frequency signals to a vehicle radio receiver, where the signals are reproduced over radio speakers.

The system of Kinzalow is similar to that described by Pan because it uses simple FM transmission to communicate audio information to a car audio receiver. Like Pan, Kinzalow does not disclose the two-way transmission and reception of data. Moreover, Kinzalow does handle not packetize data. Therefore, Kinzalow does not anticipate the claimed invention because it does not describe a wireless protocol module "wherein the wireless protocol module is configured to transmit and receive packetized data under the wireless protocol." Applicants submit that claims 43, 45, 47, 48 and 51 are allowable for at least the reasons stated above and request the rejection based on Kinzalow be withdrawn.

7. Claim Rejections Under 35 U.S.C. 103(a)

A. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,304,764 to Pan in view of U.S. Patent No. 6,697,638 to Larsson et al.

Larsson discloses a system for operating a cellular phone using Bluetooth with a car kit by providing an interface that can interact with a cellular telephone, and which is adapted to be mounted to a car. See column 1, lines 42-55.

As mentioned above, Pan describes a hands-free cellular kit which contains an electrical circuit and connector for exchanging audio information with a connected cellular phone. The aim of Pan is to provide "accessories that permit hands-free use of a cellular phone in an environment, such as in an automobile, and that work in synergistic relationship with pre-existing automobile audio technology" (emphasis added). See column 1, lines 6-15. Referring to a specific example of Pan, "audio data received by the cellular phone from the person with whom the user is communicating by cellular connection is advantageously output through the speakers 26 of the car stereo via the car stereo amplifier 24 such that anyone riding in the car may hear clearly." See column 5, lines 28-35. The hands-free cellular car kit of Pan thus utilizes the car's radio

receiver, which satisfies the aim of Pan that the car kit be used "with pre-existing automobile audio technology." In other words, Pan envisions "pre-existing automobile audio technology" to be a car stereo. While Specification 1.0 of Bluetooth was not released to the public until 1999, Bluetooth can not be considered "pre-existing audio technology" in 1999 when Pan was filed, because the first products using Bluetooth were not released until 2002.

Further, there is no suggestion in Pan that using anything other than FM transmission would be necessary, since the kit only works with a car stereo and therefore functions only to transmit data and not also to receive data. Therefore, one of ordinary skill in the art at the time the invention was made would not be motivated to use Bluetooth, as described by Larsson, with the hands-free cellular kit of Pan because the hands-free cellular kit of Pan only needs simple one-way FM transmission technology to connect to a car stereo.

In sum, applicants request the rejection of claim 46 based on obviousness be withdrawn.

B. Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,304,764 to Pan in view of U.S. Patent No. 5,771,438 to Palermo et al.

Claim 49 is dependent on claim 45 and therefore is patentable for the same reasons as claim 45.

8. Conclusion

Overall, none of the applied references, singly or in any motivated combination, teach or suggest the features recited in independent claims 37, 43 or 45 and thus such claims are allowable. Since these independent claims are allowable, based on at least the above reasons, the claims which depend from them are likewise allowable. If the undersigned attorney has overlooked a relevant teaching in any of the references, the Examiner is requested to point out specifically where such teaching may be found.

In view of the foregoing, the claims pending in the application comply with the requirements of 35 U.S.C. § 112 and patentably define over the applied art. A Notice of Allowance is, therefore, respectfully requested. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned at (206) 359-3599.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665, under Order No. 101948001US2 from which the undersigned is authorized to draw.

Dated: March 9, 2005

Respectfully submitted,

By 

Christopher J. Daley-Watson

Registration No.: 34,807

PERKINS COIE LLP/CW

P.O. Box 1247

Seattle, Washington 98111-1247

(206) 359-8000

(206) 359-7198 (Fax)

Attorney for Applicant